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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,792	02/27/2002	Shadman Zafar	01-1001	5488

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,792

Applicant(s)

ZAFAR ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

1. Claims 13 and 15 have been cancelled by Applicant.
2. Claims 1-12, 14, and 16-21 are presented for examination.

Claim Objections

3. Claim 1 is objected to because of the following informalities: The claim should read 'A method for alerting a called party...'. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12, 14, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,771,949 by Corliss in view of U.S. Patent Application Publication No. US 2002/0077082 by Cruickshank.

Regarding claim 1, Corliss discloses a method for alerting a called party of a voice mail from a calling party via a network comprising a telephone network, a data network (Figure 1, 34), and at least one gateway device (Figure 1, 30) connected to both the telephone network and the data network (see Abstract; see Figure 1), the method comprising: receiving a first message inherently including an identifier of the calling party and the voice mail message (column 5, lines 34-59); and providing a second message including the calling party identifier and a voice mail message notification to the called party via the data network (column 7, line 62 – column 8, line 8).

Corliss does not disclose providing a second message including the voice mail message to the called party via the data network.

Cruickshank discloses a method for alerting a called party of a voice mail from a calling party via a network comprising a telephone network, a data network (Figure 1, 112), and a voice messaging server (Figure 1, 102) connected to both the telephone network and the data network (see Abstract; see Figure 1), the method comprising: receiving a first message inherently including an identifier of the calling party and the voice mail message (section 0006, lines 1-5;); and providing a second message including the calling party identifier and voice mail message to the called party via the data network (section 0029, lines 4-18).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Corliss to include a second message including the voice mail message as taught by Cruickshank to send the voice message to the called party. One of ordinary skill in the art would have been lead to make such a modification since a notification including the calling party identifier and the voice mail message is sent to the called party in order for the called party to be alerted of voice mail from a calling party.

Regarding claim 2, the method of claim 1 mentioned above, wherein Corliss further discloses the telephone network is inherently a public switched telephone network (column 5, lines 1-6).

Regarding claim 3, the method of claim 1 mentioned above, wherein Corliss further discloses the telephone network is a wireless telephone network (column 4, lines 24-34).

Regarding claim 4, the method of claim 1 mentioned above, wherein Corliss further discloses receiving the first message comprises: connecting to an intelligent peripheral device in

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the telephone network, wherein the intelligent peripheral device is connected to a voice mailbox (column 5, lines 7-33); and obtaining, via the intelligent peripheral device, the voice mail message notification (column 6, line 53 – column 7, line 3).

Corliss does not disclose obtaining, via the intelligent peripheral device, the voice mail message from the voice mailbox.

Cruickshank discloses obtaining, via the voice messaging server, the voice mail message (section 0016, lines 1-15).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Corliss to include obtaining the voice mail message as taught by Cruickshank to send the voice message to the called party. One of ordinary skill in the art would have been lead to make such a modification since the first message identifies the voice mail message that needs to be obtained.

Regarding claim 5, the method of claim 1 mentioned above, wherein Corliss further discloses providing the second message to the called party via the data network comprises providing the message to a server in the data network associated with the called party; and the server causing notification of the message to appear on a display device visible to the called party (column 6, lines 5-29; column 7, lines 4-40).

Regarding claim 6, the method of claim 5 mentioned above, wherein Cruickshank further discloses providing the second message to the server comprises providing the second message using an instant messaging server (section 0015, lines 18-21; section 0029, lines 1-18).

Regarding claim 7, Cruickshank discloses a method of receiving voice mail and inherently providing voice mail information to a voice-mailbox owner in which a calling party

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inherently places a telephone call by transmitting signaling information corresponding to a telephone number, and leaves a voice mail message (see Abstract; section 0006, lines 1-9; section 0019, lines 1-6; section 0020, lines 1-3), the method comprising: registering the voice mailbox owner using an instant messaging server (section 0015, lines 18-21; section 0028, lines 1-5; section 0029, lines 1-4); receiving from the calling party the signaling information corresponding to the telephone number; receiving from the calling party the voice mail message; storing the voice mail message in a voice mail storage memory (section 0006, lines 1-9; section 0019, lines 1-6); generating a voice mail alert message corresponding to the voice mail message, the voice mail alert message including the voice mail message; and transmitting the voice mail alert message to an instant messaging server (section 0028, line 1 – section 0029, line 18).

Regarding claim 8, Corliss discloses a method for providing voice mail indication to a user in a system comprising a data network (Figure 1, 34) and a telephone network (see Figure 1), the method comprising: inherently receiving via the telephone network a voice mail for the user; storing the voice mail in the telephone network (column 5, lines 7-50); sending a message to a server or Internet gateway (Figure 1, 30) connected to the data network, the message including a voice mail notification; and storing the voice mail notification in a database accessible by the data network (column 9, lines 18-35).

Corliss does not disclose sending a message including the voice mail.

Cruickshank discloses a method for providing voice mail indication to a user in a system comprising a data network (Figure 1, 112) and a telephone network (see Figure 1), the method comprising: inherently receiving via the telephone network a voice mail for the user (see Abstract); storing the voice mail in the voice messaging server (section 0006, lines 1-9; section

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0019, lines 1-6); sending a message to the data network, the message including the voice mail; and storing the voice mail in the voice messaging server accessible by the data network (section 0021, lines 1-17; section 0028, line 1 – section 0029, line 18).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Corliss to include sending a message including the voice mail as taught by Cruickshank to send the voice message to the called party. One of ordinary skill in the art would have been lead to make such a modification since a notification including the voice mail message is sent to the called party in order for the called party to be alerted of voice mail from a calling party.

Regarding claim 9, the method of claim 8 mentioned above, wherein Cruickshank further discloses: receiving a request from the user for accessing the voice mail (section 0032, lines 1-5).

Regarding claim 10, the method of claim 8 mentioned above, wherein Cruickshank further discloses: receiving a request from the user for manipulating the status of the voice mail (section 0032, lines 5-32).

Regarding claim 11, the method of claim 10 mentioned above, wherein Cruickshank further discloses manipulating the status of the voice mail further comprises inherently connecting to the telephone network and changing the voice mail status based on the request (section 0031, line 1 – section 0032, line 32).

Regarding claim 12, please see the rejection of the method in claim 1 mentioned above, to reject the system in claim 12.

Regarding claim 14, the system of claim 12, wherein Corliss further discloses the gateway device is capable of connecting to an intelligent peripheral in the telephone network

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(column 5, lines 7-33) and obtaining the voice message notification from the intelligent peripheral (column 6, line 53 – column 7, line 3).

Corliss does not disclose obtaining, via the intelligent peripheral device, the voice mail message.

Cruickshank discloses obtaining, via the voice messaging server, the voice mail message (section 0016, lines 1-15).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Corliss to include obtaining the voice mail message as taught by Cruickshank to send the voice message to the called party. One of ordinary skill in the art would have been lead to make such a modification since the first message identifies the voice mail message that needs to be obtained.

Regarding claim 16, the system of claim 15, wherein Corliss further discloses the gateway device is capable of providing the second message to a server in the data network associated with the called party (column 6, line 53 – column 7, line 3).

Regarding claim 17, the system of claim 15, wherein Corliss does not disclose the gateway device providing the voice message notification using an instant messaging server.

Cruickshank further discloses the voice messaging server for providing the voice message notification to the called party comprises means for providing the voice message notification using an instant messaging server (section 0028, line 1 – section 0029, line 18).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Corliss to include providing voice mail notification via the gateway device as taught by Cruickshank to send the voice message to the called party. One of

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ordinary skill in the art would have been lead to make such a modification since the called party that is in communication with an instant messenger server can be notified of a voice mail message by the instant messenger server.

Regarding claim 18, Corliss discloses an apparatus comprising: a telephone network (see Figure 1); a first transmitter or voice response unit (Figure 1, 18) connected to the telephone network; a data network (Figure 1, 34); a second transmitter or server (Figure 1, 31 or 33) connected to the data network (column 6, lines 5-29); a gateway (Figure 1, 30) connected to both the first transmitter and the second transmitter, said gateway being capable of receiving a voice mail from the first transmitter (column 5, lines 7-50) and providing a message to a called party including the voice mail notification via the second transmitter (column 6, line 53 – column 7, line 24).

Corliss does not disclose providing a message to a called party including the voice mail via the second transmitter.

Cruickshank discloses an apparatus comprising: a telephone network (see Figure 1); a data network (Figure 1, 34); an instant messaging server (Figure 1, 122) connected to the data network; a voice messaging server (Figure 1, 102) connected to both the telephone network and the data network, said voice messaging server being capable of inherently receiving a voice mail from the telephone network (section 0015, lines 1-14) and providing a message to a called party including the voice mail notification via the instant messaging server (section 0028, line 1 – section 0029, line 18).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Corliss to provide a message to a called party including the

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voice mail as taught by Cruickshank to send the voice message to the called party. One of ordinary skill in the art would have been lead to make such a modification since a notification including the voice mail message is sent to the called party in order for the called party to be alerted of voice mail from a calling party.

Regarding claim 19, the apparatus of claim 18 mentioned above, wherein Corliss further discloses the first transmitter is inherently capable of receiving signaling information containing notification of the message from the voice mailbox (column 5, line 52 – column 6, line 2; column 7, lines 21-40).

Regarding claims 20 and 21, please see the rejection of the method in claims 5 and 6 mentioned above, to reject the apparatus in claims 20 and 21.

Response to Arguments

6. Intended Use Limitations: A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (see MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus the claim limitations in claims 12, 14, and 16-20 above that employ phrases of type: “CAPABLE OF”, e.g. ‘a telephone network capable of’, ‘the gateway device capable of’, etc. These are typical of claim limitations, which may not distinguish over the prior art. The references noted above have the structure and functions of performing the claimed limitations.

7. Applicant's arguments with respect to claims 1-12, 14, and 16-21 received on June 21, 2004 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication US 2001/0003202 by Mache et al teach a system that enables real-time transmission of messages, such as voice mail, via instant messaging, wherein dedicated gateways transfer a message from one transfer medium to another transfer medium

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

August 31, 2004

Allan Hoosain
ALLAN HOOSAIN
PRIMARY EXAMINER